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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,180	01/26/2004	Philippe Lamoine	033818-047	6517
21839	7590	05/17/2006		
BUCHANAN INGERSOLL PC (INCLUDING BURNS, DOANE, SWECKER & MATHIS) POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			EXAMINER MAKI, STEVEN D	
			ART UNIT	PAPER NUMBER
			1733	

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/763,180

Applicant(s)

LAMOINE ET AL.

Examiner

Steven D. Maki

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2-22-06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13,17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13,17 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>012604,110504</u> . | 6) <input type="checkbox"/> Other: _____ |

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- 1) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 2) Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 11, there is no antecedent basis for "the reinforcing filer".

- 3) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- 4) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Japan 519

- 5) **Claims 1-3, 9, 11, 17 and 18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Japan 519 (JP 2000-185519).**

Japan 519 discloses a tire having a tread formed from tread rubber comprising an insulating silica containing first rubber portion 9a and a conductive carbon black containing second rubber portion 9b. The rubber portions 9a, 9b can be arranged in

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annular rings or spirally arranged. An electrically conductive route is formed between a road surface and the belt of the tire so as to discharge static charge.

The claimed profile element is anticipated by Japan 519's tread rubber for a tire tread. In any event: it would have been obvious to form Japan 519's tread rubber such that it comprises conducting means having electrically conducting layers which are generally concentric as claimed since Japan 519 teaches forming an insulating silica containing first rubber portion 9a and a conductive carbon black containing second rubber portion 9b so as to define annular rings or a spiral configuration such that an electrically conductive path for static discharge is obtained.

6) Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Japan 519 as applied above and further in view of Poulbot (WO 00/27655).

As to claim 10, it would have been obvious locate a conducting film at the lateral faces of Japan 519's silica reinforced tread in view of Poulbot's suggestion to locate a conductive films at the lateral faces of a silica reinforced tread (figure 2) in order to reduce radio interference.

7) Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japan 519 as applied above and further in view of Hogan (US 6,399,692) and optionally Motogami et al (US 5,118,745).

As to claims 12 and 13, it would have been obvious to include the claimed conducting composition in Japan 519's conductive rubber portion since Hogan et al and the optional Motogami et al suggest using a composition comprising polyether and ionic salt to improve conductivity. It is emphasized that Hogan et al specifically suggests

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using such material for rubber of a tire tread. It is noted that Motogami et al suggests using polyether (polymer or copolymer), metal slat and solvent.

Delorme and Johnson

8) Claims 1-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Delorme (US 2,174,779) in view of Johnson (US 2,138,378).

Delorme and Johnson disclose an extruded element comprising different colored helically arranged materials. See figure 15 of Delorme and figure 6 of Johnson. In Delorme (figure 15), the extruded element comprises generally concentric layers. In Johnson, the different colored materials are different colored rubbers.

As to claims 1-3, 9 and 11, it would have been obvious to one of ordinary skill in the art to use rubber for the different colored materials in Delorme's figure 15 embodiment since (1) Delorme and Johnson disclose an extruded element comprising different colored helically arranged materials and (2) Johnson suggest using different colored rubbers as different colored materials. Furthermore, it would have been obvious to use silica reinforced rubber and carbon black reinforced rubber for the different colored rubbers suggested by Johnson since it is well known / conventional per se in the rubber art to use silica reinforced rubber to provide white rubber and carbon black reinforced rubber to provide black rubber. With respect to "conducting" and "insulating", silica is an electrically insulating material and carbon black is an electrically conductive material.

As to claims 4-8, it would have been obvious to form "conical filaments" as claimed depending on the desired characteristics of the end product in view of

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Delorme's teaching to helically form the different colored materials as shown in the figure 15 embodiment.

Allowable Subject Matter

- 9) **Claims 4-8 would be allowable if (1) rewritten in independent form including all of the limitations of the base claim and any intervening claims and (2) amended to include the subject matter of claim 12.**

There is no motivation to improve conductivity of Delorme or Johnson's extruded profile using the conductivity improving material (polyether and metal salt) of Hogan et al and/or Motogami et al.

Remarks

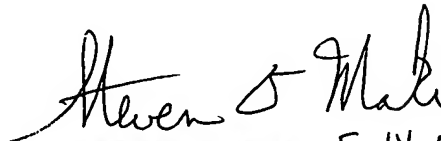
- 10) The remaining references are of interest.

11) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven D. Maki whose telephone number is (571) 272-1221. The examiner can normally be reached on Mon. - Fri. 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Steven D. Maki
May 14, 2006


STEVEN D. MAKI 5-14-06
PRIMARY EXAMINER